

<b>Office Action Summary</b>	<b>Application No.</b> 10/006,389	<b>Applicant(s)</b> THOREL, JEAN-NOEL	
	<b>Examiner</b> Susan Coe Hoffman	<b>Art Unit</b> 1655	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 08 September 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-3,5,7,8,10-13,16,18-23 and 29 is/are pending in the application.
- 4a) Of the above claim(s) 21 and 22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3,5,7,8,10-13,16,18-20 and 29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |  |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. <u>9/08</u> .                               |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application  |
| Paper No(s)/Mail Date _____.   | 6) <input type="checkbox"/> Other: _____.                          |

Art Unit: 1655

### **DETAILED ACTION**

1. A request for continued examination under 37 CFR 1.114 was filed in this application after appeal to the Board of Patent Appeals and Interferences, but prior to a decision on the appeal. Since this application is eligible for continued examination under 37 CFR 1.114 and the fee set forth in 37 CFR 1.17(e) has been timely paid, the appeal has been withdrawn pursuant to 37 CFR 1.114 and prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on November 7, 2007 has been entered.
2. Claims 1-3, 5, 7, 8, 10-13, 16, 18-23 and 29 are currently pending.

### ***Election/Restrictions***

3. As discussed with Hee Smith on September 3, 2008, the restriction requirement issued August 6, 2008 was erroneous while the restriction requirement issued February 19, 2008 is correct. Thus, the restriction requirement of August 6, 2008 is withdrawn in favor of the restriction requirement from February 19, 2008. Applicant's election in response to the requirement, filed April 29, 2008, is considered herein.

Applicant's election with traverse of water and triglycerides for the species in the reply filed on April 29, 2008 is acknowledged. The traversal is on the ground(s) that a search of all of the species would not be burdensome. This is not found persuasive because claim 1 is directed to at least two members selected from a Markush group with over forty members. Thus, claim 1 reads on hundreds, if not thousands of composition. A search of over a hundred different compositions would clearly be burdensome.

The requirement is still deemed proper and is therefore made FINAL.

Art Unit: 1655

4. Claims 21 and 22 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim.

Applicant timely traversed the restriction (election) requirement in the reply filed on April 29, 2008.

5. Claims 1-3, 5, 7, 8, 10-13, 16, 18-20, 23 and 29 are examined on the merits solely in regards to the elected species.

#### ***Claim Objections***

6. Claim 1 is objected to because of the following informalities: "triglycerides" is misspelled. Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1, 2, 5, 7, 12, 13, 16, 18-20, and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by prior public use in light of Wilder (US 4,695,456) providing evidence of inherency.

Applicant's claims are drawn a two phase composition that contains at least 98% of a plurality of biodermal constituents (defined by applicant as ingredients found in the skin (see

Art Unit: 1655

page 2 of the specification)). Applicant has elected water and triglycerides as the biodermal constituents.

Applicant's claims are considered to be anticipated by prior public use of water for bathing or soaking of the body. The surface of human skin contains sebum which contains triglycerides (see column 4, lines 48-50 of Wilder). While bathing or soaking the body in water, the sebum would mix with the water used for bathing or soaking. Since lipids and water are immiscible, this would produce a two phase composition.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1, 3, 5, 7, 8, 10, 11, 13, 16, 18, 19, 23, 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Seidel (WO 95/22313 - US 5,830,483 is the English translation of WO '313, for ease it will be referred to in the rejection) in view of Bernstein (US 5,508,034).

Seidel teaches a topical oil-in-water emulsion which contains 50 to 99% water, 1 to 30% of an oil phase and below 1% by weight of an emulsifier (see column 1, lines 31-44). The emulsifier would function as a stabilizer because it would keep the emulsion in the oil-in-water formation. The reference teaches that the oil phase can be made up of triglycerides (see claims 1 and 13). However, the reference does not specify the use of biodermal triglycerides.

Art Unit: 1655

Bernstein teaches making cosmetic compositions using triglycerides extracted from the stratum corneum of the skin. The reference teaches that cosmetics made with these stratum corneum components are superior in comparison to cosmetics that are not made with these components (see column 1, lines 33-end). Thus, an artisan of ordinary skill would reasonably expect that stratum corneum triglycerides could successfully be used as the source of the triglycerides in the oil phase of the emulsion taught by Seidel. An artisan would expect this modification to improve the composition of Seidel as suggested by Bernstein. This reasonable expectation of success would have motivated the artisan to modify Seidel to include biodermal triglycerides in the emulsion.

The references do not specifically teach a water-in-oil dispersion. However, water-in-oil dispersions were well known in the art at the time of the invention to be useful forms for cosmetics to have. An artisan of ordinary skill would have been motivated to modify the formulation taught by the references to form a water-in-oil emulsion as well as the oil-in-water emulsion specifically taught.

9. Claims 1-3, 5, 7, 8, 10-13, 16, 18-20, 23 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bernstein (US 5,508,034) in view of Wilder (US 4,695,456) and Ziegler (US 5,310,556).

Bernstein teaches a composition for treating the skin. The composition comprises three classes of lipids naturally found in the stratum corneum layer of the skin including triglycerides, cholesterol and lecithin (see column 1, line 49 - column 2, line 18 and claims). The reference also teaches that water can be used as a vehicle (see Examples). The composition can be applied with only the skin lipids, non-biodermal ingredients are not specifically required (see abstract

Art Unit: 1655

and column 1, lines 53-54). The reference does not specifically teach formulating the composition into a two phase form or a composition that consists only of water in combination with the skin lipids.

Wilder teaches that skin irritation is caused by chemical irritants found in cosmetics (see column 1, lines 7-10). Wilder teaches that to avoid skin irritation, cosmetics should be formulated into creams, emulsions, oil-in-water or water-in-oil emulsions, and other known cosmetic forms using non-allergenic carriers. The reference specifically suggests using 50 to 100% water as such a non-allergenic carrier (see column 5, lines 9-13 and 33-35, claims 1, 6 and 8).

Ziegler teaches that cholesterol and lecithin when mixed with water and triglycerides form a stable emulsion (see column 5, line 62 - column 6, line 5). Thus, an artisan would expect that adding water to the cholesterol, lecithin, and triglycerides taught by Bernstein would form a non-allergenic emulsion such as those taught by Wilder. An artisan would be motivated to make such a composition because the artisan would reasonably expect that using only non-allergenic, skin components would produce a non-irritating cosmetic.

10. No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan Coe Hoffman whose telephone number is (571) 272-0963. The examiner can normally be reached on Monday-Thursday, 9:30-5:30.

Art Unit: 1655

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terry McKelvey can be reached on (571) 272-0775. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Susan Coe Hoffman/  
Primary Examiner, Art Unit 1655